

REMARKS

Claims 1–4 are pending in this application. By this Amendment, claims 1–4 are amended. Support for the amendments can be found, for example, in pages 5 and 6 of the specification. No new matter is added. Applicant respectfully requests reconsideration and prompt allowance in view of at least the following remarks.

The courtesies extended to Applicant's representatives by Examiner MacArthur at the interview held on June 26, 2008, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below, which constitute Applicant's record of the interview.

The Office Action rejects claims 1–4 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. The Office Action lists various minor informalities that allegedly render the claims indefinite. As agreed upon during the interview, the amendments to the claims correct all the informalities. Applicant respectfully requests withdrawal of the rejection.

The Office Action rejects claims 1–4 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,690,581 (Umemoto). Applicant respectfully traverses the rejection.

During the interview, the Examiner referenced M.P.E.P. §2112.01 and case law discussing that where the claims at issue and the applied references are identical or substantially identical in structure, a *prima facie* case of either anticipation or obviousness is established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). The Applicant has the burden of proving that the applied references do not necessarily inherently possess the properties or functions of the claims only after a *prima facie* has been established. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. However, the Office Action fails to sufficiently establish that the structure recited in the claims and allegedly disclosed in the

applied reference are identical or substantially identical. Rather, Office Action only broadly alleges that Umemoto discloses all of the limitations recited in the claims "as best understood" in view of the §112, second paragraph, rejection. The Office Action fails to meet the requirements of establishing identical or substantially identical structure by failing to point out the specific portions of Umemoto that allegedly disclose the recited features in the claims. Rather, as indicated by the Examiner during the June 26 personal interview, Umemoto was used as a mere formality to include a substantive rejection within the Office Action. Thus, the Office Action has failed to sufficiently establish anticipation or obviousness under the requirements of §102 or §103.

The Examiner expressed during the interview that functional language recited in apparatus claims lacks patentable weight. Applicants respectfully disagree. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. M.P.E.P. §2173.05(g). Although a functional clause in a claim that merely states the necessary result of the limitations in that claim might not add to the patentability or substance of the claim (*Texas Instruments Inc. v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 1172 (Fed. Cir. 1993)), the Federal Circuit has repeatedly recognized that functional clauses that define structural limitations cannot be disregarded. *See, e.g., Pac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796, 801 (Fed. Cir. 1990), citing *In re Venezia*, 530 F.2d 956 (C.C.P.A. 1976).

Even if the limitations of claim 1 were considered functional (which Applicant traverses), the limitations define structural limitations, which cannot be disregarded. The allegedly functional limitations recited in the present claims do not merely state the necessary result of the limitations but instead further functionally define the structural features of the claims. For example, the deformation portion of the ball seat recited in claim 1 must be

structurally able to elastically deform the ball seat in a rotational direction about the center axis of the shaft portion. Thus, a *prima facie* case of anticipation or obviousness can only be established by asserting applied references that disclose the same allegedly functionally defined structural features. The Office Action fails to meet this burden.

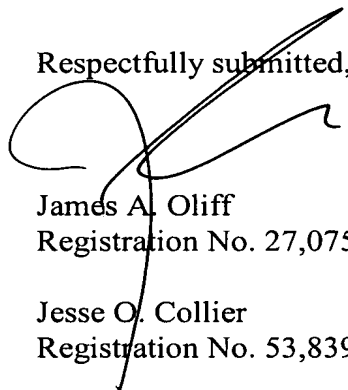
Umemoto fails to disclose the structural features of claim 1. Specifically, Umemoto at least fails to disclose "a deformation portion of the ball seat configured to elastically deform the ball seat in a rotational direction," as recited in claim 1. Nor does Umemoto disclose upper and lower ball seats that include "frictional engagement surfaces," as recited in claim 1, "configured to elastically deform the deformation portion of the ball seat in the rotational direction." Rather, Umemoto discloses a ball joint with a metal ball 2 coupled to a socket 13, the socket 13 including a ball seat 20. The ball seat 20 includes a hard lower ball seat 4 and a soft upper ball seat 9. However, the ball seats 4 and 9 are prevented from rotating together with the stud 1. Instead, Umemoto discloses "the rotational friction torque is stabilized without being affected by the change of dimension and change in temperature, and the ball seat is prevented from rotation together with the stud" (Umemoto at col. 1, lines 57–60). Therefore, Umemoto fails to disclose all the features of claim 1. Additionally, as dependent claims 2–4 depend from claim 1, Umemoto fails to disclose dependent claims 2–4. Applicants respectfully request withdrawal of the rejection.

During the interview, the Examiner briefly referred to several other references not of record, namely U.S. Patent Application Publication No. 2003/0180089 (Heuser), U.S. Patent No. 4,324,501 (Herbenar), U.S. Patent No. 4,318,627 (Morin) and U.S. Patent No. 3,602,560 (Mammel). However, none of these references, either alone or in combination, disclose or would have rendered obvious the presently recited claims.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:

Petition for Extension of Time

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